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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,220	02/16/2001	Richard E. Barnett	401056/GRAY	2530

7590 07/02/2004

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EXAMINER
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VUONG, QUOCHIE B

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/784,220

Applicant(s)

BARNETT ET AL.

Examiner

Quochien B Vuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15 and 17-32 is/are rejected.
- 7) ☒ Claim(s) 13 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 02/16/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

2. The disclosure is objected to because of the following informalities: page 1, the filing date of the parent application, 09/122,880, now U.S. Patent No 6,192,223, was ***July 28, 1998***, not ***July 26, 1998***.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 and 17-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 recite the limitation "the transmitter" and "the transceiver" in claim 1, lines 12-13 and 14, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claims 17-25 recite the limitation "the geographical location" in claim 17, lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitation "the geographical location", line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 27-32 recite the limitation "the geographical location" in claim 27, line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 10-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Lyons (US 6,282,412).

Regarding claim 10, Lyons discloses a programmable frequency scanning radio receiver (figures 1 and 3) comprising: a receiver (10) for receiving radio frequency transmissions at each of a plurality of discrete frequencies; a memory (column 3, lines 51-56) for storing frequency data, the frequency data including a plurality of frequencies corresponding to respective transmitting parties of interest located within a reception range of the geographical location of the frequency scanning radio receiver;

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a data base (12) of frequency allocations and geographical location information corresponding to the frequency allocations, internal to the frequency scanning radio receiver, for programming the frequency scanning radio receiver (column 3, lines 57-65); and a processing circuit (112) coupled to the memory, the receiver, and the data base, assembling the frequency data from the data base, based on the geographical location of the frequency scanning radio receiver, storing in the memory the frequency data assembled from the data base, and controlling the receiver to monitor transmissions only at the frequencies of the frequency data in the memory (column 3, line 42 – column 5, line 8).

Regarding claim 11, Lyons discloses a method of automatically programming a frequency scanning radio receiver (10) to monitor transmissions only on programmed discrete frequencies comprising: determining the geographical location of the frequency scanning radio receiver through a first communication device (116) coupled to the frequency scanning radio receiver by communicating with a geographical positioning system in response to the geographical location determination, assembling frequency data from a data base (12) including frequency allocations and geographical location information corresponding to the frequency allocations for locations proximate the geographical location of the frequency scanning radio receiver, determined through the first communication device; supplying the frequency data from the data base to a memory in the frequency scanning radio receiver; and in response to the frequency data received from the data base, programming the frequency scanning radio receiver to monitor transmissions only on operating

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frequencies of the frequency data (column 3, line 42 – column 5, line 8).

Regarding claim 12, Lyons discloses the data base is internal to the frequency scanning radio receiver and including assembling the frequency data with a search engine within the frequency scanning radio receiver (column 3, lines 57-65).

Regarding claim 15, Lyons discloses automatically determining the geographical location of the frequency scanning radio receiver through the first communication device at respective time intervals (periodically) (column 4, lines 41-43).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons.

Regarding claim 14, Lyons discloses the first communication device (GPS 116) to determine the geographical location of the frequency scanning radio receiver. Although Lyons does not explicitly disclose manually requesting the first communication device to determine the geographical location of the frequency scanning radio receiver. However, it would have been obvious to adapt a manually requesting the geographical location to the method of Lyons in order for the user to know the geographical location of the frequency scanning radio receiver which usually installed in a vehicle (see Lyons, column 4, lines 43-45).

#### ***Allowable Subject Matter***

10. Claims 13 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 13, Lyons fails to disclose wherein the data base is located in a host system remote from the frequency scanning radio receiver and including sending a programming request to the host system through a second communication device internal to the frequency scanning radio receiver, and receiving the frequency data from the host system through the second communication device, the frequency data being assembled in the host system.

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Regarding claim 16, Lyons fails to disclose in response to a determination of current geographical location of the frequency scanning radio receiver, determining distance between the current geographical location and the geographical location since last access of the data base, and assembling the frequency data only if the distance exceeds a minimum distance.

11. Claims 1-9 and 17-32 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Regarding independent claims 1, 17, 26, and 27, Lyons discloses a method and programmable frequency scanning radio receiver (figures 1 and 3) comprising: a receiver (10) for receiving radio frequency transmissions at each of a plurality of discrete frequencies; a memory (column 3, lines 51-56) for storing frequency data, the frequency data including a plurality of frequencies corresponding to respective transmitting parties of interest located within a reception range of the geographical location of the frequency scanning radio receiver; a data base (12) of frequency allocations and geographical location information corresponding to the frequency allocations, internal to the frequency scanning radio receiver, for programming the frequency scanning radio receiver (column 3, lines 57-65); and a processing circuit (112) coupled to the memory, the receiver, and the data base, assembling the frequency data from the data base, based on the geographical location of the frequency scanning radio receiver, storing in the memory the frequency data assembled from the data base, and controlling the receiver to monitor transmissions only at the frequencies of the frequency data in the memory (column 3, line 42 –



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column 5, line 8). However, Lyons fails to disclose a transmitter or a transceiver, wherein the processing circuit also coupled to the transmitter or transceiver and controlling the transmitter or transceiver to operate only at the frequencies of the frequency data in the memory.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ahlemeyer et al. (US 4,888,815) discloses scanning radio receiver.

Schwob (US 4,969,209) discloses broadcast receiver capable of selecting station based upon geographical location and program format.

Shiota (US 5,471,662) discloses radio data system receiver.

Kishi (US 5,535,442) discloses FM tuner having improved tuning speed.

13. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA 22202. Sixth Floor (Receptionist).

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Any inquiry concerning this communication from the examiner should be directed to Quochien B. Vuong whose telephone number is (703) 306-4530. The examiner can normally be reached on Monday through Friday from 9:30 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377.



**QUOCHIE B. VUONG**  
**PRIMARY EXAMINER**

Quochien B. Vuong

May 28, 2004.